IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nintendo of America, Inc. Attorney Docket No: NOAM-2-0819

Serial No: 330,932

Filed: October 5, 1981

Mark: DONKEY KONG & Design

SUPPLEMENTAL PETITION TO MAKE APPLICATION SPECIAL

Seattle, Washington 98121

March 11, 1982

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Previously, the undersigned applicant petitioned the Commissioner under 37 CFR 2.146 to designate the above-identified pending application as "special" and to advance it out of the normal order of examination in accordance with TMEP 1102.04. That petition was received in the Patent and Trademark Office on November 2, 1981, and in a response thereto the Director of Trademark Examining Operations, Herbert C. Wamsley, in a letter dated January 27, 1982, denied the petition on the grounds that mere anticipation of infringement of the trademark was an insufficient basis for granting special status to the application.

The undersigned applicant now comes forth to supplement the original petition filed November 2, 1981, with evidence of actual infringements as set forth below. The following supplemental proof is to be considered together with the declarations made by the undersigned applicant and petitioner in the above-mentioned original petition filed November 2, 1981.

Therefore, in support of this supplemental petition, applicant and petitioner state:

1) That on or about October 20, 1981, an employee of the undersigned applicant received information from one of the applicant's distributors in California that an infringing audio-visual game, bearing the trademark DONKEY KONG was being offered for sale through an arcade called "Space World" in Gilroy, California; that as a result of such information, applicant hired an investigator to visit the business location of "Space

EXHIBIT 34 DATE 8-30-82
WITNESS
Sheila M. Macarino

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World" and as a result of that investigator's effort, certain photographs and other evidence of infringement, including trademark infringement of the name DONKEY KONG was obtained, which evidence is in the possession of the attorneys of record, Christensen, O'Connor, Johnson & Kindness, of Seattle, Washington, for the undersigned applicant, under an attorney's file marked NOAM 5 1222; applicant refrains from submitting this evidence to the Trademark Office for the reason that the infringer is a potential defendant in litigation that may be brought by the undersigned applicant and as such the evidence is considered confidential.

2) That prior to September 1981, applicant received information through its employees that a video game operator d/b/a Fantasy Amusements, Inc. of Renton, Washington, was making infringing audio-visual games bearing the DONKEY KONG trademark; as a result of that information, the undersigned applicant, acting through its attorneys, Christensen, O'Connor, Johnson & Kindness, of Seattle, Washington, investigated those reports and uncovered proof of such infringement whereupon an action to restrain such infringement was brought in the United States District Court for the Western District of Washington under Civil Action No. C81-1278M; this litigation was subsequently resolved in the form of a Consent Judgment, Decree, and Permanent Injunction against the defendant, Fantasy Amusements, Inc. and the principals thereof, which was entered by the Court Clerk on January 18, 1982.

3) That information was developed during the proceedings against Fantasy Amusement, Inc. in Civil Action No. C81-1278M, which led to the investigation of activities of still another party that was engaged in infringement of applicant's trademark DONKEY KONG for audio-visual games; that such other party was doing business under the name of Weilco, Inc. of Seattle, Washington, Ron Weil, principal; that pursuant to extra judicial discussions with Weilco, Inc. and Ron Weil, an out-of-court settlement was reached in which Weilco, Inc. and Ron Weil agreed to cease infringing use of the name DONKEY KONG for audio-visual games and further agreed to hand over labels and name plates bearing the infringing trademark, however it is not known whether all infringing labels were recovered.

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4) That prior to December 1978, applicant received information that an audio-visual game that was similar to or the same as applicant's copyrighted game sold under the trademark DONKEY KONG was being marketed under the name CRAZY KONG; as a result of such information an investigation conducted by agents of applicant uncovered evidence of infringement and based thereon applicant brought suit in the United States District Court for the Central District of California against Chris Anderson and others in Civil Action No. CV81-6359-RMT(TX) in a Complaint filed on December 17, 1981; that this civil action is still pending and that the Court has granted a Preliminary Injunction against certain of the named defendants on the basis of Findings of Fact dated and signed February 12, 1982, by U.S. District Court Judge Robert M. Pakasugi, including Findings Nos. 34 and 35 which state:

> 34. The similarity between the nonfunctional design characteristics of defendants' CRAZY KONG counterfeit game and plaintiff's original DONKEY KONG is such that defendants' unauthorized games are taken to be from or approved by Nintendo by the consuming public.;
>
> 35. One of the selling points of defendants' infringing CRAZY KONG games is their similarity to the genuine DONKEY KONG game.;

that applicant submits that its asserted trademark right in the name DONKEY KONG when considered in the light of the activities of defendants Anderson and others as set forth in the Findings of Fact and Conclusions of Law in the aforementioned civil action creates likelihood of confusion between the names DONKEY KONG and CRAZY KONG.

5) That applicant is aware of at least ten other specific reports of infringement of its audio-visual game sold under the trademark DONKEY KONG, which infringing games use either an identical or a confusingly similar name, including the above-mentioned CRAZY KONG, and such variations thereof as KING KONG and DONKEY KING.

That, in summary, the undersigned applicant and petitioner herein has now submitted evidence of actual infringement of its trademark rights and since this omission was apparently the only basis for the denial of the petition to make special, reconsideration of the petition, supplemented by the above evidence, is requested and early granting of the petition is in order.

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Minoru Arakawa states that he is the President of Nintendo of America Inc., applicant and petitioner herein, and is authorized to execute this petition on behalf of said corporation; that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any registration resulting therefrom.

NINTENDO OF AMERICA INC.

Date MARCH 17, 1982

By _____

Minoru Arakawa, President



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